PATENT
Customer No. 22,852
Attorney Docket No. 01142.0101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Mark PAUSCH *et al.*	)	Group Art Unit: 1647
	)	
Application No.: 09/786,056	)	Examiner: S. Wegert
	)	
International Filing Date: September 1, 1999	)	
	)	Confirmation No. 6857
For: ENHANCED FUNCTIONAL EXPRESSION OF G PROTEIN-COUPLED RECEPTORS	)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. §§ 1.144 and 1.181
FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Pursuant to 37 C.F.R. § 1.144 and 37 C.F.R. § 1.181, Applicants respectfully petition the Commissioner to review the restriction requirement set forth in the Office action mailed April 22, 2003. The restriction requirement was made final in the Office action mailed September 23, 2004, at pp. 2-3.

The Office has issued three separate restriction requirements in this application. Applicants seek review of the third requirement. In the second restriction requirement mailed on September 9, 2002, the Office asserted that the pending claims were directed to 10 separate and distinct inventions. Claims 13 and 26 were placed into Group II, which Applicants elected with traverse in their Amendment and Response filed February 7, 2003. Applicants amended claim 13 and 26 to convert them from dependent to independent claims. In addition, Applicants requested entry of claims 52-85, which with

the exception of claim 81, each depended from claims 13 and 26. All of the claims pending after entry of the Amendment (13, 26, and 52-85) were directed to a method of screening compounds that bind to a G protein-coupled receptor to cause cell growth. In other words, they were all directed to what the Office asserted constituted Group II.

Following entry of the Amendment, the Office further restricted the invention of Group II, purportedly in view of new claims 52-85. The Office contends that the claims do not form a single inventive concept under PCT Rule 13.1. Office action mailed April 22, 2003, page 2. The Office now concludes that the claims constitute nine distinct inventions. *Id.*, pages 2-3. Applicants were required to elect a single invention for prosecution. *Id.*, page 2.

In response, Applicants elected to prosecute Group IX, claims 70-80, 82, 83, and 85 drawn to a method of screening compounds that bind to a G protein coupled-receptor in a host cell, with traverse. Response to Restriction Requirement filed September 22, 2003, page 2. For Group IX, the Office also required Applicants to elect one heterologous G-protein coupled receptor from the list set forth on pages 4 and 5 of the Office action. Applicants elected a human α2A adrenergic receptor, with traverse. *Id.* Subsequently, the Office included claims 26 and 52 with the other claims of Group IX. Office action mailed September 23, 2004, page 2.

Applicants traverse the restriction requirement for the following reasons. First, Applicants fail to understand how the Office can place claims 13 and 26 into the same group in the prior previous restriction requirement, but in the later restriction requirement assert that these claims fall into two distinct groups. According to the Office, "[c]laims 13 and 26, as amended, read on distinct inventions." Office action mailed September

23, 2004, page 2. However, Applicants amended claims 13 and 26 to convert them from dependent to independent claims, and did not add any other limitations. Thus, Applicants submit there is no basis for treating these claims differently now than they were treated in the second restriction requirement. For this reason alone the Commissioner should reverse the restriction requirement.

The Office appears to justify the new restriction requirement on the fact that "Applicants newly filed claims are drawn to several patentably distinct inventions." Office action mailed April 22, 2003, page 2. To the extent the Office is relying on entry of the dependent claims as justifying the instant restriction requirement, Applicants respectfully disagree. With the exception of claim 81, all of the new claims are dependent on claims 13 or 26.

Applicants submit that if independent claims 13 and 26 possess unity of invention as the Office determined in the Office action mailed September 9, 2002, then claims that depend from claims 13 and 26 must also possess unity of invention. In other words, if claims 13 and 26 recite a special technical feature, then claims depending from them must also recite that feature. A dependent claim includes all of the limitations of the claim(s) from which it depends. The dependent claims, therefore, must also recite the special technical feature. The fact that the dependent claims recite additional aspects of the invention does not alter this conclusion. For this reason it is improper for the Office to now split claims 13 and 26 into separate groups merely because claims depending from claims 13 and 26 were entered into the application.

Furthermore, by this reasoning, it is also improper for the Office to place any of these claims into groups that do not include claims 13 and 26, as the Office has done

with Groups III-IX. Office action mailed April 22, 2003, pages 2-3. Because all of the dependent claims placed into Groups III-IX recite the special technical feature of independent claims 13 and 26, there must be unity of invention under PCT Rule 13.1. The Office should therefore examine all of the pending claims on the merits in this application.

As part of its reasoning purporting to support the requirement, the Office contends that the nine groups of claims each have independent utility. Office action, page 4. However, the utility of the claims is recited in the preamble: "[a] method for screening compounds capable of binding to G protein-coupled receptors . . . ." *See* claims 13, 26, and 81. **All of the pending claims are directed to this method.** None of the claims recite any other utility. Even if the claims in groups I-IX "can be used each independently" to study any of the listed items on page 4 of the Office action, that is not relevant to whether the claims possess unity of invention. Moreover, the Office asserts at page 4 that "the claimed methods are practiced . . . for materially different purposes . . . and goals," but this is incorrect. As is clear from the claim language, the goal of all of the methods is "screening for compounds capable of binding to G protein-coupled receptors . . . ." Contrary to the Office's conclusions, all of the claims are directed to the same purpose.

In the context of the Office's further requirement to pick a single receptor that applies to groups V and IX, the Office asserted that each receptor type is distinct from the other because "they have different putative functions, different structures, and require completely different search terms." Office action, pages 5-6. Respectfully, the invention is not the receptor type used in the claimed methods. The claims are directed

to a method of screening compounds. The Office's requirement that Applicants elect a single receptor type improper as the receptor is not relevant to the issue of whether there is unity of invention. Accordingly, the Office should also withdraw this requirement.

Restriction of claims 13, 26, and 52-85 into nine groups and seventeen receptor types is inappropriate under the unity of invention standard of PCT Rule 13.1. In view of the foregoing remarks, Applicants respectfully request that the Commissioner grant Applicants' request and withdraw the restriction requirement and the requirement to elect a single species.

Please grant any extensions of time required to enter this Petition and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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